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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,623	03/04/2002	Ulf Eriksson	1064/44833C2	8185

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EXAMINER

MERTZ, PREMA MARIA

ART UNIT PAPER NUMBER

1646

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/086,623

**Applicant(s)**

ERIKSSON ET AL.

**Examiner**

Prema M Mertz

**Art Unit**

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Groups 1-5. Claims 1-14, 17, 23, 27-29, are drawn to a nucleic acid encoding a polypeptide of amino acid sequence set forth in SEQ ID NO: 4, 6, 8, 36 or 38, a vector, a host cell and a process for producing the polypeptide, classified in Class 435, subclass 69.1.

Groups 6-10. Claims 15, 16, 18-21, are drawn to a polypeptide of amino acid sequence of set forth in SEQ ID NO: 4, 6, 8, 36 or 38, classified in Class 530, subclass 399.

Group 11. Claim 22, is drawn to a nucleic acid encoding a polypeptide of amino acid sequence set forth in SEQ ID NO: 25, classified in Class 536, subclass 23.5.

Groups 12-19. Claims 24-25, are drawn to primers of nucleotide sequence set forth in SEQ ID NO: 26, 27, 30, 31, 33, 34, 41, 42, classified in Class 536, subclass 24.3.

Group 20. Claim 26, is drawn to a method of identifying specific tumors using a nucleic acid encoding a PDGF-D polypeptide, classified in Class 435, subclass 6.

Should any one of the Groups from 1-5 be elected, Applicant is required to select one polypeptide (one amino acid sequence) as set forth in SEQ ID NO: 4, 6, 8, 36 or 38. Should any one of the Groups from 12-19 be elected, Applicant is required to select one primer sequence as set forth in SEQ ID NO: 26, 27, 30, 31, 33, 34, 41, 42. Once one sequence is selected, all other sequences will be withdrawn from consideration.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1-5, 6-10, 11, 12-19, are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and

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each has an independent utility, that is distinct for each invention which cannot be exchanged. The nucleic acids of inventions 1-5, 11, can be used to make hybridization probes or can be used in gene therapy as well as in the production of the specific proteins of interest. The proteins of inventions 6-10 can be used as probes, or used therapeutically or diagnostically, e.g. in screening. The primers of inventions 12-19 can be used to amplify the nucleic acids to obtain the encoded proteins. Each of the nucleic acids of inventions 1-5 can be used to produce the specific polypeptides of Groups 6-10, respectively. The polynucleotide of Group I can only be used to produce the protein of Group 6 but not the proteins of Groups 7-10.

Inventions I-5 and 6-10 are related as processes of making and products made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case each of the proteins can be prepared by materially different processes, such as by chemical synthesis, or obtained from nature using various isolation and purification protocols.

Inventions I-5, 11 and 20 are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the products of inventions I-5, 11 can also be used in production of the protein of interest.

Inventions 6-10, 20 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they

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have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

#### ***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961.

Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.


Information regarding the status of an application may be obtained from the Patent application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Prema Mertz Ph.D.  
Primary Examiner  
Art Unit 1646  
July 8, 2004